

Appl. No. 09/559,159
Amdt. Dated September 19, 2005
Reply to Office Action of June 17, 2005

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action, and amended in response thereto.

Claims 1-17 remain in this application.

Because applicants believe that this current Office Action had improperly been made final, Applicant's discussed this issue with the Examiner by telephone on September 14, 2005, during which the Examiner had said that he would investigate the matter. On September 19, 2005, the Examiner called the Applicant's representative to confirm that the finality of the current action was improper, and that the finality would be withdrawn. The Examiner said to treat the Office Action as a non-final Office Action, which Applicant's representative has done.

Claims 1-6 were again rejected under 35 U.S.C. §103(a) as being unpatentable over Portuesi (U.S. 6,499,057) in view of the GIS article (Internet GIS and Its Applications in Transportation). For the following reasons, the rejection is respectfully traversed.

Claim 1, as amended, recites a "moving picture coding means for producing *compressed moving picture data* using a *moving picture coding format* and having a high image quality from the *still picture data* coded using a *still picture coding format* and obtained from said picture data relaying means." Claim 4 recites similar limitations.

The Examiner argues that the MPEG format utilized by QUICK TIME utilizes I, P, and B frames that supposedly represent still images (actually, one skilled in the art would know that they represent individual *frames* of *moving* images, not a still image as recited in the claims). However, the I, P, and B frames of the MPEG format were coded according to a *moving picture coding format* (there is no need for such a plurality of frames in a still picture format such as JPEG). Basically, the claim recites that a *still* image coded using a *still image*

Appln. No. 09/559,159
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format is reproduced in a *moving picture format* by the apparatus and then displayed as a still image using the moving picture format. None of the references teach such a device.

Accordingly, even if the features of Internet GIS and QuickTime (as taught by Portuesi) were combined, that would not suggest the "moving picture coding means" as defined in claims 1 and 4, and thus claims 1 and 4 are patentable over the references. Claims 2-6, which depend on either claim 1 or claim 4 are patentable over the references for at least the same reasons as the parent claim.

Furthermore, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some *suggestion or motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish *prima facie* obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness (*Id.*). Merely stating that the combination is "obvious" is not motivation.

The Examiner argues that the motivation is provided because it would enable Portuesi to have a zoom feature as taught by GIS, thereby "enabling the image provider to be notified and thus enabling the user to view a selected image in more detail so that the user may more finely review the image." However, this argument is nothing more than a conclusory benefit of the secondary reference, and is not sufficient to support a *prima facie* case of obviousness. The Examiner must show a convincing reason that the reader would add that benefit to the *base* reference. This has not been done.

Accordingly, because no proper motivation has been provided, the rejection for obviousness is improper, and the rejection should be withdrawn.

Arguments/Remarks

Page 13 of 15

Appln. No. 09/559,159
Amdt. Dated September 19, 2005
Reply to Office Action of June 17, 2005

Claims 7-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Portuesi in view of GIS and further in view of Tracton (U.S. 6,470,378) in further view of Guedalia (U.S. 6,536,043). For the following reasons, the rejections are respectfully traversed.

First, Applicant notes that claim 17 is newly rejected, the Examiner having added the Guedalia reference in the current Office Action. This reference is added to teach a "mobile terminal, and deriving a second image from the first image." Applicant notes that this teaching is directed toward claim limitations that were not amended in the previous amendments provided by Applicant. Thus, this is a new rejection that was not necessitated by the prior amendments, and thus the finality of this rejection, as sent, is improper.

Similarly, the rejection of claims 7, 9-14, and 16-17 are newly rejected by adding the Guedalia reference. In particular, claims 7 and 9 were not amended in the prior supplied amendments, and thus this action is improperly made final for these reasons as well.

Furthermore, claims 7, 13, and 17 each recite similar limitations as discussed for claim 1. Accordingly, claims 7, 13, and 17 are patentable over the references for at least the same reasons as claim 1. The remaining claims depend, directly or indirectly, on one of claims 7, 13, and 17, and thus are patentable over the references for the same reasons as the parent claims.

Finally, the Examiner has again failed to provide legally sufficient motivation for combining the references, and thus the rejection is improper.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

Appl. No. 09/559,159
Amdt. Dated September 19, 2005
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If there are any additional fees resulting from this communication, please charge same
to our Deposit Account No. 16-0820, our Order No. 32626.

Respectfully submitted,
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Date: September 19, 2005